

REMARKS

I. General

The issues raised by the Office Action dated July 14, 2005 include:

- Claims 8 and/or 12 appear to stand rejected under 35 U.S.C. 112, second paragraph;
- Claims 1-8, 10-14, 16-23 and 25-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Smith et al., U.S. Pat. No. 5,455,409 (hereinafter *Smith*); and
- Claims 9, 15 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Smith*.

Applicant hereby traverses the outstanding rejections of the claims, and requests reconsideration and withdrawal of the outstanding rejections in light of the amendments and remarks contained herein. Claims 15, 16 and 23 are amended above to correct typographical errors, replacing semicolons at the end of the claims with periods. Claims 1-30 remain pending in this application.

II. Rejection under 35 U.S.C. § 112

The Office Action states: “Claim 12 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” The Office Action then indicates that claim 8 recites “restricting access of said at least one selected data transfer elements to said media in a same partition as said at least one selected data transfer elements.” However, this is an element of claim 12, and not claim 8. Therefore, Applicant assumes that the Office Action intends to only reject claim 12 under 35 U.S.C. § 112, second paragraph. If this is not the case, Applicant requests a clarification in a non-final Office Action so that Applicant may have a full and fair opportunity to address the rejection of any other claim under § 112.

As read by Applicant, the Office Action seems to assert that claim 12’s recitation of “as said at least one selected data transfer elements,” at the end of the claim, is confusing, can not be clearly understood and is redundant. Although Applicant respectfully asserts that the

meaning of the claim is clear, Applicant has amended claim 12 above to further clarify the claim, without changing the meaning or scope of the claim. Hence, Applicant respectfully asserts that claim 12, particularly as amended, clearly claims that the commanding step includes restricting access of the one or more selected data transfer elements to media that is in a same partition as that (or those) data transfer element(s). Accordingly, the 35 U.S.C. § 112, second paragraph, rejection with respect to claim 12 should be withdrawn.

III. Rejections under 35 U.S.C. §102(b)

Claims 1-8, 10-14, 16-23 and 25-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Smith*. Applicant respectfully traverses these rejections for the reasons advanced below.

The recited reference does not teach all claimed elements.

It is well settled that to anticipate a claim, a reference must teach every element of the claim, see M.P.E.P. §2131. Moreover, in order for a reference to be anticipatory under 35 U.S.C. §102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. § 2131, citing *In re Bond*, 15 US.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejections do not satisfy one or more of these requirements, as detailed below.

The preamble of independent claim 1 recites: “A method for securing access to a data medium.” Similarly, the preamble of independent claim 14 recites: “A method for securing access to data media in a particular partition of a partitioned data library.” The Examiner is respectfully reminded that M.P.E.P. § 2111.02, citing *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989), provides: “Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.” The Office Action does not address the preambles of claims 1 and 14, other than to generally state “Smith discloses a method for securing access to a data medium” and “Smith discloses a method for securing access to a data medium in a particular

partition of a partitioned data library,” without citing any portion of *Smith* in support thereof. However, *Smith* is directed to systems and methods for monitoring a location of an article, such as a tapes cassettes, in a large collection, such as a library, and is silent as to accessing or securing access to data media, such as the aforementioned tape cassette. Further, with respect to independent claim 14, *Smith* is silent concerning partitioning a data library, as discussed in greater detail below.

Independent claim 1 further recites “commanding at least one selected data transfer element in said library to only accept media having particular ones of said identification numbers” (emphases added). Similarly, independent claim 14 recites “checking said memory storage of a data transfer element receiving said selected medium for said identification number of said selected medium” (emphasis added) and “accessing said selected medium in response to said identification number of said selected medium being present in said memory storage of said data transfer element receiving said selected medium.” Independent claim 22 recites “access to said media by each of said data transfer elements is restricted to media having particular ones of said identification numbers.” *Smith* fails to teach these elements, as well. As pointed out in at least paragraphs 0016 and 0019 of the present specification, the data transfer elements are library tape drives, or the like. *Smith* is silent concerning any action taken by a drive, other than possibly reading and writing data. As noted by the Office Action on page 4, *Smith*, in column 6, lines 14-19, provides:

Upon trapping such a tape request from the mainframe computer, the host computer interrogates circuitry within each of the tape carriers to determine whether there is a match between a requested volser number and the volser numbers of tapes currently stored in the respective tape carriers.

Thus, *Smith* teaches that the tape carriers (slots) are used by the host computer to determine whether a particular tape is in a slot. Contrary to the Office Action’s contention that “the host computer interrogates circuitry within each of the tape carriers to determine whether there is a match ... in order to accept or to reject the tape media,” *Smith* clearly indicates at column 6, lines 27-29, and line 56 of column 24 through line 4 of column 25, volser matches are made “for identifying the location of the tape cartridge and transmitting data identifying the location, e.g., the aisle, rack, and carrier number, to the host computer.” Thus, *Smith* does not match volsers “in order to accept or to reject the tape media” as alleged

by the Office Action (on page 4). Additionally, *Smith* is silent concerning “memory storage of a data transfer element” as recited in claim 14. For at least the foregoing reasons, *Smith* fails to teach “commanding at least one selected data transfer element in said library to only accept media having particular ones of said identification numbers,” as recited by claim 1; “checking said memory storage of a data transfer element receiving said selected medium for said identification number of said selected medium” and “accessing said selected medium in response to said identification number of said selected medium being present in said memory storage of said data transfer element receiving said selected medium,” as recited by claim 14; and “access to said media by each of said data transfer elements is restricted to media having particular ones of said identification numbers,” as recited by claim 22.

As noted above, the preamble of claim 14 recites: “A method for securing access to data media in a particular partition of a partitioned data library” Claim 14 also recites “listing identification numbers of media that data transfer elements in said partition are allowed to access in memory storage of said data transfer elements in said partition.” The preamble of claim 22 recites : “A partitioned data library” and the body of claim 22 recites “at least one set of at least one of said slots assigned to one partition of a plurality of library partitions” and “each of at least one set of at least one of said data transfer elements assigned to one of said library partitions.” *Smith* also does not disclose these elements.

As also noted above, *Smith* is silent concerning partitions, partitioning a data library or a partitioned data library. The Office Action (in addressing claim 12) indicates column 8, lines 20-21 as teaching that “a data library is partitioned into a plurality of partitions or tape cartridges.” However, the cited portion of *Smith* merely teaches that:

The tape cartridge 10 comprises a "coded article" in that it is assigned an alphanumeric identification code or "volser" volume serial number, each of the tape cartridges within a data processing center library being assigned a unique volser number.

For at least the foregoing reasons Applicant respectfully asserts that *Smith* fails to teach “[a] method for securing access to data media in a particular partition of a partitioned data library” or “listing identification numbers of media that data transfer elements in said partition are allowed to access in memory storage of said data transfer elements in said

partition,” as recited by claim 14; or “[a] partitioned data library,” “at least one set of at least one of said slots assigned to one partition of a plurality of library partitions,” or “each of at least one set of at least one of said data transfer elements assigned to one of said library partitions,” as recited by claim 22.

For at least each of the above advanced reasons, *Smith* fails to teach each and every element of independent claims 1, 14 and 22. Therefore, Applicant respectfully asserts that at claims 1, 14 and 22 are patentable over the 35 U.S.C. § 102 rejection of record. Furthermore, there are great differences between these claims and the art of record, and a person of ordinary skill in the art considering the prior art would not find these differences obvious.

Claims 2-8 and 10-13 each ultimately depends from independent claim 1, claims 16-21 each ultimately depends from independent claim 14, and claims 23 and 25-30 each ultimately depends from independent claim 22. Thereby, each of claims 2-8, 10-13, 16-21, 23 and 25-30 inherits all elements of respective independent claim 1, 14 or 22. Thus, for at least the reasons advanced above in addressing the anticipation rejection of claims 1, 14 and 22, each of claims 2-8, 10-13, 16-21, 23 and 25-30 set forth features and elements not recited by *Smith*. Therefore, Applicant respectfully asserts that claims 2-8, 10-13, 16-21, 23 and 25-30 are also patentable over the 35 U.S.C. § 102 rejections of record.

IV. Rejections under 35 U.S.C. §103(a)

Claims 9, 15 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Smith*. In addressing claims 9, 15 and 24, the Office Action admits that *Smith* does not teach “ejecting a medium from a data transfer element in response to said identification number not being one of said particular ones of said identification numbers.” The Office Action appears to attempt to cure this deficiency by taking Official Notice and/or introducing knowledge of one of ordinary skill in the art, stating :

it would have been obvious to one having ordinary skill in the art at the time the current invention was made to readily recognize that if the VOLSER (or identification number as being claimed) are not matched, the media or tape should be ejected from the data transfer element; in doing so, it would avoid reading of wrong data in unmatched media which results to enhancing of system reliability by reducing system errors,

therefore being advantageous.

A. Examiner's Personal Knowledge

As noted above it appears the Examiner has taken Official Notice that it is well known in the art "that if the VOLSER (or identification number as being claimed) are not matched, the media or tape should be ejected from the data transfer element." Under Rule 37 C.F.R. §1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertion. Alternatively, under M.P.E.P. §2144.03, the Examiner is hereby requested to cite a reference in support of the assertion. Otherwise the rejection of claims 9, 15 and 24 should be withdrawn.

B. A Prima Facie case of obviousness has not been established.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Without conceding the second criterion, Applicant asserts that the rejection does not satisfy the first and third criteria.

1. The modified reference does not teach or suggest all claim elements.

Applicant respectfully asserts that *Smith*, as modified by the Office Action, does not teach or suggest all elements of the claimed invention. As discussed above, *Smith* fails to teach or suggest various elements of independent claims 1, 14 and 22. Further, the Office Action does not take Official Notice or indicate that the elements missing from *Smith* are known in the art. Therefore, *Smith*, even as modified by the Office Action, fails to teach or suggest all elements of independent claims 1, 14 and 22. Claim 9 depends directly from independent claim 1, claim 15 depends directly from independent claim 14, and claim 24 depends directly from independent claim 22. Thereby, each of claims 9, 15 and 24 inherits all elements of respective independent claim 1, 14 or 22. Hence, each of claims 9, 15 and 24 set forth features and elements not recited by *Smith*, as modified by the Office Action. Thus,

Applicant respectfully asserts that at least for the above reasons claims 9, 15 and 24 are patentable over the 35 U.S.C. § 103(a) rejection of record.

2. The Office Action does not provide the requisite motivation.

As noted above, the Office Action admits that *Smith* fails to teach or suggest “ejecting a medium from a data transfer element in response to said identification number not being one of said particular ones of said identification numbers.” The Office Action appears to attempt to cure this deficiency by taking Official Notice and/or introducing knowledge of one of ordinary skill in the art. The motivation for making the modification was presented as follows:

it would have been obvious to one having ordinary skill in the art at the time the current invention was made to readily recognize that if the VOLSER (or identification number as being claimed) are not matched, the media or tape should be ejected from the data transfer element; in doing so, it would avoid reading of wrong data in unmatched media which results to enhancing of system reliability by reducing system errors, therefore being advantageous. (Pages 12 and 13 of Office Action.)

However, the Office Action also states:

it should be noted that *Smith* also discloses upon trapping the tape request from the mainframe computer, the host computer interrogates circuitry within each of the tape carriers to determine whether there is a match between a requested volser number and the volser numbers of tapes currently stored in the respective tape carriers. (Page 12 of Office Action.)

Elsewhere, the Office Action (on page 4, in addressing independent claim 1) indicates that *Smith* teaches:

the host computer interrogates circuitry within each of the tape carriers to determine whether there is a match between a requested volser number and the volser numbers of tapes currently stored in the respective tape carriers in order to accept or to reject the tape media.

Assuming *ad arguendo* that *Smith* teaches “the host computer interrogates circuitry within each of the tape carriers to determine whether there is a match ... in order to accept or to reject the tape media,” the advanced motivation is improper. The position that “the host computer interrogates circuitry within each of the tape carriers to determine whether there is a match ... in order to accept or to reject the tape media” is inconsistent with the stated motivation, “it would have been obvious...that if the VOLSER...are not matched, the media or tape should be ejected from the data transfer element.” According to the Office Action, *Smith* teaches that recognition at the tape carrier is used to accept or reject tapes, not ejecting tapes from a data transfer element (e.g. a tape drive). In that *Smith* teaches that this recognition takes place in a carrier and not in a tape drive (or other data transfer element), nothing in *Smith* would suggest motivation for modifying *Smith* such that if the VOLSER are not matched, the media or tape should be ejected from a data transfer element, as the recognition is not performed by a tape drive, or the like, in *Smith*.

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. §2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. §2143.01. Moreover, M.P.E.P. § 2141.02 directs that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” Additionally, “[i]t is improper to combine references where the references teach away from their combination,” M.P.E.P. § 2145. Whereas, the Office Action’s interpretation of *Smith* in addressing claim 1 teaches away from the proposed modification to *Smith*, Applicant respectfully asserts that the motivation provided by the Office Action also fails to state any desirability for making the modification.

Further, Applicant respectfully asserts that the Examiner seems to be relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Applicant’s disclosure. Applicant asserts that without the teachings of Applicant’s disclosure one of ordinary skill in the art would not find it obvious to supplant the alleged teachings of *Smith* that “the host computer interrogates circuitry within each of the tape carriers to determine whether there is a match ... in order to accept or to reject the

tape media” with alleged knowledge in the art providing that “it would have been obvious... that if the VOLSER ...are not matched, the media or tape should be ejected from the data transfer element.” Given the Examiner’s interpretation of the teachings of *Smith* in addressing claim 1, it appears that the Examiner is relying on the teachings of the present application to conclude that one of ordinary skill in the art would be motivated to modify *Smith* to eject a medium if the VOLSER is not matched.

For at least the forgoing reasons, the motivation provided by the Office Action is improper, insufficient and inconsistent with other statements advanced in the Office Action. No valid suggestion has been made, absent the application of impermissible hindsight, as to why a combination of *Smith* and common knowledge is desirable. Therefore, the rejection of claims 9, 15 and 24 should be withdrawn.

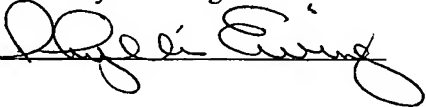
IV. Conclusion

For all the reasons given above, Applicant submits that the pending claims distinguish over the prior art of record under 35 U.S.C. §§ 102 and 103, and meet the requirements of 35 U.S.C. §112. Accordingly, Applicant submits that this application is in full condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 30014514-1, from which the undersigned is authorized to draw. Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that the attorney can helpful in resolving any remaining issues or can otherwise be helpful in expediting prosecution of the present application.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 629200000US in an envelope addressed to: M/S Amendment, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: 10/14/2005

Typed Name: Phyllis Ewing

Signature: 

Respectfully submitted,

By: 

Jerry L. Mahurin
Attorney/Agent for Applicant(s)
Reg. No. 34,661
Date: 10/14/2005
Telephone No. (214) 855-8386